# UNITED STATES PATENT AND TRADEMARK OFFICE

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| 09/538,556 | 03/29/2000 | Eileen C. Shapiro | 1525C/107 | 6059 |

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| ART UNIT | PAPER NUMBER |
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| 3623 | |

DATE MAILED: 11/19/2003     2 0

Please find below and/or attached an Office communication concerning this application or proceeding.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)☒ Responsive to communication(s) filed on <u>07 November 2003</u>.

2a)☐ This action is **FINAL**.  2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)☒ Claim(s) *1-17,19,20,22,23 and 25-29* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17,19,20,22,23 and 25-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
since a specific reference was included in the first sentence of the specification or in an Application Data Sheet.
37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific
reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4)☐ Interview Summary (PTO-413) Paper No(s). _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: .

# DETAILED ACTION

1.      The following is a Non-Final Office Action upon the receipt of the Request for Continued

Examination of application number 09/538556.  Claims 1-17, 19, 20, 22, 23 and 25-29 are

pending and have been examined on the merits discussed below.

## *Response to Arguments*

2.      As per Applicants arguments that Puram et al does not teach forced choice questions,

Examiner respectfully disagrees.  Puram et al does teach forced choice questions to reveal

preferences.  As shown in figures 5-9, the questions to reveal preferences are presented in a way

to "force" the respondent to answer, as opposed to an open ended format.  The questions are

formed so that the respondent is lead to give specific information.  In figure 5, the respondent

answers specific questions about technical skills.  The respondent is "forced" to enter

information such as specific hardware he or she has worked with and the number of years

working in that area, as opposed to a format wherein the respondent is asked an open ended

question such as "tell us everything about your technical skills".  New rejections addressing the

amendments are located below.

## *Claim Rejections - 35 USC § 102*

3.      The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United
> States before the invention thereof by the applicant for patent, or on an international application by another who

has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4.      **Claims 1, 3, 5-13, 16, 17, 19, 22, 23, and 25-29** are rejected under 35 U.S.C. 102(e) as being anticipated by Puram et al, U.S. Patent No. 6,289,340 B1.

As per **claim 1** (amended), Puram et al teaches a method for facilitating evaluation comprising:  obtaining for each of the parties (employers) in the first class and storing in a first digital storage medium responses from at least one of the party and a party co-evaluator to a first set of forced choice questions designed to permit analysis of the responses so as to reveal underlying party preferences that can be used to estimate the closeness of such party's fit with a counterparty (candidates) in such context and obtaining for each of the counterparties in the second class and storing in a second digital storage medium responses from at least one of the counterparty and a counterparty co-evaluator to a second set of forced choice questions designed to permit analysis of the responses so as to reveal underlying counterparty preferences that can be used to estimate the closeness of such counterparty's fit with a party in such context (column 2, lines 44-55, column 3, lines 53-56 - in this reference the "employers" and "candidates" provide data regarding the skills desired or possessed and that information is stored within a storage medium; figures 5-9, the questions to reveal preferences are presented in a way to "force" the respondent to answer, as opposed to an open ended format. The questions are formed so that

the respondent is lead to give specific information. In figure 5, the respondent answers specific

questions about technical skills. The respondent is "forced" to enter information such as specific

hardware he or she has worked with and the number of years working in that area, as opposed to

a format wherein the respondent is asked an open ended question such as "tell us everything

about your technical skills"); deriving from the responses to the first set of questions for each

such party a first preference profile for each such party through analysis of the responses and

deriving from the responses to the second set of questions for each such counterparty a second

preference profile for each such counterparty through analysis of the responses(column 1, lines

10-13; profiles are generated and stored for candidates and positions to be filled (employer

profile)), and in a separate computer process, analyzing the preference profiles of the party and

counterparty to generate a list of counterparties for which the preferences of the party closely

match the preferences of the counterparty and the preferences of the counterparty closely match

the preferences of the party and communicating the first list to such party (column 7, lines 6-22,

65-67).

As per **claim 3**, Puram et al teaches the first list ranked according to the closeness of fit

(abstract; the candidates are ranked according to adjusted skills scores to yield best-fit matches).

As per **claims 5 and 6**, Puram et al teaches obtaining responses from each of the parties

and counterparties is accomplished using communication over a communication network

(column 3, lines 7-8).

As per **claims 7 and 8**, Puram et al teaches obtaining responses from each of the parties

and counterparties includes making web pages available providing the questions and permitting

entry by such party or counterparty of responses thereto (column 3, lines 50-58, column 5, lines 60-67).

As per **claim 9**, Puram et al teaches questions eliciting revelation of a utility value which indicates the value that the party places on the level of the attribute (column 5, lines 60-65; the party (employer identifies the skills desired and indicates the priority of that skill).

As per **claim 10**, Puram et al teaches questions eliciting revelation of a utility value which indicates the value that the counterparty places on the level of the attribute (column 5, lines 36-42; the counterparty (candidate) indicates priority of preferred geographic region of employment or willingness to travel).

As per **claim 11**, Puram et al teaches analyzing the preference profile of the party in relation to the preference profiles of the counterparties using a measure of distance between a set of utility values created with respect to the first series of attributes and a set of utility values created for the second series of attributes (column 7, lines 6-13, 21-25, 51-69; the search only returns those candidates whose skills profiles matches or exceeds the specified criteria).

As per **claim 12**, Puram et al teaches a set of questions requiring the party to rank each of a non-null set of items from among a plurality of possible ranks (column 2, lines 44-49; the employer provides data regarding the skills desired and the priority of that skill for the position).

As per **claim 13**, Puram et al teaches a set of questions requiring the counterparty to rank each of a non-null set of items from among a plurality of possible ranks (column 5, lines 36-42; the counterparty (candidate) inputs preference data, for example, the candidate inputs his or her preferred geographic location).

As per **claim 16**, Puram et al teaches the preference profile of each party associates a utility value to indicate the value which the party places on the level of the attribute (column 5, lines 60-67, column 2, lines 44-50; the party (employer) identifies the importance or priority of the skills desired as part of the preference data that is gathered and stored in the profile).

As per **claim 17**, Puram et al teaches the preference profile of each counterparty associates a utility value to indicate the value which the counterparty places on each level of the attribute (column 5, lines 35-42, column 2, lines 50-55; the counterparty (candidate) indicates preference values for each attribute which are stored in the profile).

As per **claim 19**, Puram et al teaches a party co-evaluator is an associate of the party (Puram teaches a third party evaluation of the candidate (column 3, lines 20-25), inherently this evaluation would come from an associate or someone who knows the candidate, otherwise, the third party evaluation would not be accurate)

As per **claim 22**, the same rejection as applied to claim 1 above is applied to claim 22. Claim 22 is the computer process for implementing the steps of claim 1.

As per **claim 23**, the same rejection as applied to claim 1 above is applied to claim 23. Claim 23 is a question and response module for obtaining the information claimed in claim 1. Puram et al teaches separate interfaces for collecting the profile information (column 3, lines 20-25), and also teaches storing the information in separate storage media (column 2, lines 44-55).

As per **claim 25**, the same rejection as applied to claim 1 above is applied to claim 25. In claim 25, the database is structured for storing the information obtained in claim 1. Puram et al teaches separate databases for the profile information gathered from the party (employer) and the counterparty (candidate).

As per **claim 26**, the same rejection as applied to claim 16 above is applied to claim 26.

In claim 26, the information obtained in claim 16 is stored in the database of claim 25.

As per **claim 27**, the same rejection as applied to claim 17 above is applied to claim 27.

In claim 27, the information obtained in claim 17 is stored in the database of claim 25.

As per **claim 28**, the same rejection as applied to claim 11 above is applied to claim 28.

As per **claim 29**, the same rejection is applied to claims 1 and 23 above as applied to

claim 29. In claim 29, the database is structured for storing the information obtained in claim 1

by the question and response module in claim 23.


## *Claim Rejections - 35 USC § 103*

5.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

6.      **Claims 2, 4, 14, 15 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable

over Puram et al, U.S. Patent No. 6,289,340 B1 and CareerMosaic. The following rejections are

based on CareerMosaic.com. Applicant is reminded that the following rejections are based on

the product of CareerMosaic.com

CareerMosaic.com web pages 1-16 were retrieved from the "Wayback Machine"

(web.archive.org). The CareerMosaic.com web pages referenced were archived on April 12,

1997.

As per **claim 2**, Puram et al teaches communicating, to a party (employer), a list of counterparties (candidates) whose preference profiles closely fit with those of the parties but does not teach communicating, to a counterparty, a list of parties for which the preferences of the party closely match the preferences of the counterparty and the preferences of the counterparty closely match the preferences of the party. CareerMosaic.com offers a way for counterparties to receive a list of parties with whom their preferences match (pg 5 – a description of the CareerMosaic J.O.B.S. database, where the counterparty enters criteria important to the job search and the second list of companies (parties) that match are returned. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Puram et al to include the list presented to the counterparty as well. The motivation for doing so would be so that both the employer and candidate could make a more informed decision. For example if the counterparty was not presented with a list of matching parties, he or she may be inclined to take the first offer for a job. Whereas, is the counterparty knew of the parties who might be contacting them, they could make a better decision on whether to take their first offer.

As per **claim 4**, Puram et al teaches the second list ranked according to the closeness of fit (abstract; the candidates are ranked according to adjusted skills scores to yield best-fit matches). Puram et al does not teach a ranked list of parties. It is old and well known in the art to rank lists to group more relevant results together. It would have been obvious to one of ordinary skill in the art at the time of the invention to generate a ranked list of matching parties as well, so both the employers and candidates could make a well-informed decision on filling and selecting a position. A real world example would be that a candidate who receives more than one offer for employment and/or interview would choose the potential employer that best

appeals to the candidate. It is for this reason one would be motivated to generate a ranked list of matching parties.

As per **claim 14**, Puram et al teaches all the limitations of claim 14, as applied to claim 9 above, but does not teach the questions revealing values without explicitly asking for the values. Puram et al teaches the party assigning a desired skill level for skills such as operating systems, languages, project experience, etc. (column 6, lines 11-14). By assigning a desired skill level to those skills, it would be obvious to one of ordinary skill in the art at the time of the invention to imply that one without those skills (or one with other skills) are not needed for the position. The motivation of using this type of question is to help the counterparty to realize what type of person is being sought after for the job. If the counterparty does not have the skills given the most priority, they would know they are not qualified.

As per **claim 15**, Puram et al teaches all the limitations of claim 15, as applied to claim 10 above, but does not teach the questions revealing values without explicitly asking for the values. Puram et al teaches the counterparty identifying their geographic location preference (column 5, lines 35-42). It would be obvious to one of ordinary skill in the art at the time of the invention to imply from that question whether or not the counterparty is willing to relocate. For example, if the candidate was living in one state and their geographic preference was in another state, the party could imply that the counterparty is willing to relocate. The motivation of using this type of question is to help the party to find a counterparty to is available for a position in a certain geographic region and if that counterparty is willing to relocate from their current location. If the position is in a state that the counterparty is not willing to relocate to, the party would not contact that counterparty.

As per **claim 20**, Puram et al does not explicitly teach the counterparty co-evaluator is

one of an associate, a member of a group to which the counterparty belongs, a parent or guardian

of the counterparty, an advisor to the counterparty, a relative of the counterparty, and a friend of

the counterparty. It would be inherent that there would be a counterparty co-evaluator involved

in any business transaction such as hiring a candidate (as in the Puram reference). It is well

known in general hiring practices to involve more than one person in the hiring process. A

hiring manager may set forth skills needed for the job and have them reviewed by another person

in the group such as his or her manager or the person for which the candidate will be working.

This type of practice ensures that the list of skills needed includes everything relevant to the job

opening.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Johnna R Stimpak whose telephone number is 703-305-4566.

The examiner can normally be reached on M-F 8am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone number for the

organization where this application or proceeding is assigned is 703-746-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is 703-305-1113.

JS
11/17/2003

Susanna Diaz
Susanna Diaz,
Primary Examiner
A.U. 3623